

Remarks/Arguments:

DETAILED ACTION

The Examiner states that Claims 1-10 and 16-20 are currently pending in the instant application. Claims 11-15 were cancelled by preliminary amendment.

The Applicants respectfully point out that Claims 1, 2, 4-10 and 16-20 are pending in the application. Claims 3 and 11-15 were cancelled in response to the restriction requirement and Claims 16 and 18-20 are withdrawn pending rejoinder. This is correctly stated in the Office Action Summary.

In response to this official action Claims 1, 2, 4-8, 10, 16 and 17 have been amended. Claim 9 has been cancelled.

I. Priority

The Examiner states that the instant application is a 371 of PCT/GB04/03546, filed on August 18, 2004, which claims benefit of Foreign Application UNITED KINGDOM, filed on August 22, 2003.

Applicants concur and state for the record that the UK priority application is GB 0319759.7.

II. Information Disclosure Statement

The Examiner states that the information disclosure statements (IDS) submitted on June 12, 2006 and March 13, 2007 have been considered by the Examiner. See Applicant's copies of the 1449.4.

Applicants note this and the enclosed initialed form PTO/SB/08's enclosed with the Official Action.

III. Restriction/Election

A. Election: Applicant's Response

Applicants' election without traverse of Group I in the reply filed on March 13, 2007 is acknowledged by the Examiner. The Examiner states that after a telephonic interview with attorney Lucy Padgett on March 13, 2007, the Examiner has included the following subject matter in claim 1 of Group I that reads "or, when n is 2, the two R¹ groups, together with the carbon atoms of A to which they are attached, may form a 4 to 7 membered saturated ring optionally being substituted by one or two methyl groups". The Examiner further states that Applicants cancelled claim 3 in the Remarks/Arguments filed on the Subject matter not

encompassed by elected Group I are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

Applicants thank the Examiner for agreeing to the variation to the original restriction requirement.

IV. Rejection(s)

Claim Rejections - 35 USC § 112

(1) Claims 1, 2, 4-10 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the term "prodrug" in the above claims are not defined in the specification so as to know the structures of the compounds that are included and/or excluded by the term. Therefore, the Examiner concludes, the specification lacks adequate support for Claims 1, 2, 4-10 and 17.

(2) Claims 1, 2, 4-10 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a compound of formula (1) (See pages 45-61 of the specification), does not reasonably provide enablement for a prodrug of a compound of formula (1). The Examiner states that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Applicants respectfully assert that the term "prodrug" is both clear and enabled in view of the discussion in the specification (see, for example, pages 7-8 and the many examples of suitable pro-drugs contained therein) combined with the common general knowledge in the art (as discussed in the references listed on page 7 of the specification). However, in order to expedite prosecution, Applicants have cancelled this term in the claims. Claims 1, 2, 4-8, 10, 16 and 17 have been amended. Claim 9 has been cancelled. Applicants consider that this amendment addresses points (1) and (2).

(3) Claims 1, 2, 4-10 and 16-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the "mono- and dimethyl derivatives" in variable R_{Na} in claim 1 are not defined in the specification so as to know the structures of the compounds that are included and/or excluded by the term. Therefore, the Examiner concludes, the specification lacks adequate support for Claim 1.

(4) Claim 1, 2, 4-10 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that Claim 1 is indefinite for the reasons set forth

above under 35 U.S.C. 112, first paragraph because Claim 1 contains the terms "mono- and di-methyl derivatives" in the definition of R_{Na}, however, the "mono-and di-methyl derivatives" are not defined in the claims so as to know the metes and bounds of the claims. Therefore, the Examiner concluded, the claim is indefinite.

As described hereinbelow, Applicants have cancelled this term in the claims thus rendering objections (3) and (4) moot.

V. *Objections*

Claim Objections

Claim 17 is objected to because of the following informalities: the term "and" is missing between the last two compounds listed in the instant claim. Appropriate correction is required.

Applicants have amended this.

Claim Objection-Non Elected Subject Matter

Claims 1, 2, 4-10 and 17 are objected to as containing non-elected subject matter. To overcome this objection, the Examiner states that Applicants should submit an amendment deleting the non-elected subject matter.

The Examiner varied the original restriction requirement at Applicants' request therefore Applicants have retained some subject matter not originally indicated by the Examiner as allowable but later agreed to in the telephone interview dated 13 March 2007. Applicants therefore assume that this rejection is referring to the presence of acetals in the claims. Applicants have therefore amended Claim 1 to remove the presence of acetals.

The above amendments have been made without prejudice to Applicants right to prosecute any cancelled subject matter in a timely filed continuation application.

Applicants believe the application is in condition for allowance, which action is respectfully requested.

Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any deficiency in the fees or credit any overpayment to deposit account No. 50-3231, referencing Attorney Docket No. 101181-1P US.

Application No. 10/567,801
Amendment Dated 07/05/2007
Reply to Office Action of 04/05/2007

Respectfully submitted,

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